

### REMARKS

This response is to the non-Final Office Action mailed May 17, 2005. Claims 1-43 are pending, and have been rejected in the Office Action. In this response, Applicants have amended claim 1 to provide addition clarity, and claim 32 to provide antecedent basis that the Applicants noticed was missing. Applicants believe that the claims are in condition for immediate allowance, and request the same. The Applicants next address each of the points raised in the Office Action.

#### Rejection Under 35 U.S.C. § 102 Over Clark

The Office Action rejects claims 1-2, 4-7, 11, 13, 16, 18, 20, 23-24, 27, and 30 as anticipated under 35 U.S.C. § 102 by U.S. Patent No. 6,343,280 to Clark. Claim 1 is the sole independent claim of this group. It recites a method involving the distribution of authorization keys at intermittent times to computers on which application programs are stored and are to be run. Each key is associated with a validity period during which the key will be valid and will allow an application program to be operated. The keys are distributed electronically in a manner that is transparent to users of the computers.

The Clark patent discusses a much more complicated and inflexible system. In particular, Clark attempts to provide for copy protection of software by breaking a program apart into components before it is ever distributed to a user. The user does not get an application program, but instead gets only portions of the program. *See* Clark Patent, col. 14, lines 31-51. The other portions are provided to a "License Server." In the terms of the patent, the "Original Software" is provided to a "Software Profiler," and the user gets only "Modified Software" that is not an application program, along with a key and some "Trap Software." *Id.* The Modified Software only works when the user contacts the license server, and the other components are run from the license server. *See id.*, col. 14, lines 55-62. In short, there is no application program stored on or to be run on the user's computer, as recited by amended claim 1.

This difference is not insignificant. Rather, it introduces complexities into the Clark system that need not be present in the invention of claim 1. For example, the Clark system

requires special "Trap" software that allows the snippets of code on the user's computer to interoperate with the snippets of code on the license computer, since neither computer actually contains an application program. This complicated process is shown in Figure 2 of the Clark patent, whereby, whenever a hole in the code on the user's computer is located, the trap software has to verify the user's key with the license server, send a CPU state to the license server, wait for the license server to emulate instructions that are missing from the user's computer, and then incorporate any changes back into the user's computer and continue running whatever code is available on the user's computer. This complex process introduces a whole host of communication and coordination errors that are not present with the invention recited in claim 1. In fact, the Clark patent itself recognizes that the remote code will "execute[] more slowly because of the time of network transfer" (and requires a special Software Profiler in an attempt to split the code so as to minimize such delays). *See Clark Patent*, col. 21, lines 62-65. Also, the process requires a constant, reliable connection to the license server—yet another complicating factor involved with the Clark patent's system and method. In short, the Clark patent neither discloses nor fairly suggests the invention of claim 1 and the other rejected dependent claims, and the Applicants respectfully request allowance of the claims.

#### Rejection Under 35 U.S.C. § 103 Over Clark

The Office Action rejects claims 3, 17, 22, 25-26, 28, and 31 as obvious under 35 U.S.C. § 103 over the Clark patent. Each of these claims depends directly or indirectly on claim 1, and for the reasons discussed above, Applicants submit that they are patentable over the Clark patent.

In addition, claims 25, 26, and 31 recite that the application program can be run in multiple modes of use, and the Office Action admits that Clark does not disclose such a feature. The Office Action asserts that use in trial and actual mode would have been desired, so that such a feature would have been obvious from Clark, but the Office Action appears to rely on the teachings of the present application in recognizing such a solution. As a result, the rejection is based on an improper hindsight reasoning. Moreover, the Office Action does not identify any

motivation to alter the teachings of Clark, which plainly does not disclose or suggest this feature, so as to produce the feature that is currently claimed.

Claims 3 and 17 recite the automatic distribution of an authorization key when an existing key has expired. Again, there is nothing in Clark to suggest such an additional feature, and there is no reason to believe a skilled artisan would be motivated to use such a feature when systems that do *not* have automated re-authorization are widespread. In any event, the Office Action does not show such a feature in circumstances like those recited in the pending claims, and does not make a *prima facie* showing of a motivation to combine or modify teachings either. Applicants thus respectfully submit that the claims are in condition for allowance.

Claim 22 recites an encrypted key. Nothing in Clark suggests encryption of keys, most likely because the Clark system requires the separate presence of a license server that provides additional security to the system, so that encryption would not be needed. In any event, the statement of "official notice" does not make out a *prima facie* case of unpatentability, and Applicants respectfully request withdrawal of the objection.

Claim 28 discusses a demonstration mode in which some features are disabled. This rejection is more tenuous than the rejection of claims 25, 26, and 31, as Clark says absolutely nothing about a demonstration mode. And again, the "official notice" does not make out a *prima facie* case of unpatentability.

For each of these independent reasons, Applicants respectfully request allowance of the pending claims.

#### Rejection Under 35 U.S.C. § 103 Over Clark and Wilde

The Office Action rejects claims 10, 12, 14, 15, 21, 32, 33-40, 42, and 43 as obvious under 35 U.S.C. § 103 over the Clark patent in view of U.S. Patent No. 6,446,260 to Wilde et al. Claims 10, 12, 14, 15, and 21 depend on claim 1. Claim 32 is an independent claim, on which all of the other claims, except for independent claim 43, depend.

Claim 1 is discussed above. Claim 32 recites a method comprising distribution of copies of an application program without charge, enabling a computer user to choose among modes in

which to run the program, including a mode that does not require additional information about the user. In another mode, the user is required to self-register by providing information about the user in exchange for an authorization key (having a limited validity period) that is associated with a unique identifier of the computer on which the application program is to run, and which enables the application to be run in the chosen mode. Claim 43 recites receiving at a subscription server information identifying individual users who are permitted to use copies of an application program on computers. A user's identity is sent to the subscription server when a user first attempts to use a copy of the application program, the identity is matched to information identifying individual users, and an authorization key is provided to the computer. In short, each of these claims recites, in one form or another, an actual application program on the user's computer.

As discussed above, the Clark patent provides a user's computer only with snippets of code, and has to go to the license server for other portions of the code. Neither computer is provided with an application program, as recited in the pending claims. This code-splitting technique in Clark is central to the approach Clark takes in providing copy-protection for software. Clark in fact teaches away from a system in which an application program is stored on a user's computer, as such an approach would appear to be considered unreliable by Clark. In sum, for the reasons discussed above, the Clark patent neither discloses nor fairly suggests the inventions in the pending claims.

The Office Action relies on Wilde (for claims 10, 12, 14, 15, and 21) as disclosing the use of a key that carries information about the identity of a computer on which the application program is running, for the purpose of avoiding hacking. There would be no motivation, however, to provide such a key with Clark because Clark purports to provide security by splitting the program up into portions at the user's computer and at the license server, "because although the Software User 2 can examiner the input and output going across the network communication 17, the Software User 2 cannot determine the Modified Software's missing functionality." See Clark Patent, col.17, lines 51-55. Thus, there would have been no reason for a skilled artisan to seek to use a key such as that recited in the pending claims.

Certain other dependent claims discuss the operation of the application program in various modes (e.g., claims 33-37). The Office Action points to col. 21, lines 40-50 of the Clark Patent as allegedly disclosing various modes of operation of a program. However, that portion of the Clark Patent simply shows the ability to vary a license period, so that the software would operate in a single, full-featured mode during, for example, a trial period or a rental period. Nothing in the Clark patent either teaches or fairly suggests the ability to select or use a particular mode of operation (e.g., a mode in which some features are disabled). For this reason also, Applicants submit that these claims are in condition for allowance.

Rejection Under 35 U.S.C. § 103 Over Clark and Brandt

The Office Action rejects claims 8 and 9 as obvious under 35 U.S.C. § 103 over the Clark patent in view of U.S. Patent No. 5,758,068 to Brandt et al. Claim 8 depends on claim 1, and adds the feature of automatically providing a grace period when a validity period lapses. Claim 9 depends on claim 8 and recites the feature in which the authorization key carries information about the grace period.

As discussed above, the Clark Patent simply does not disclose or fairly suggest the features of claim 1, on which claims 8 and 9 depend. In addition, there would be no motivation to provide such a "grace" feature with the invention discussed in the Clark Patent. That is because the user in the Clark Patent must be attached permanently to the license server to make the program operate at all. As such, the user could not be expected to be operating off-line, e.g., during a period in which the user would need a grace period. In any event, the Office Action has not identified such a motivation, and thus does not make out a *prima facie* case for unpatentability.

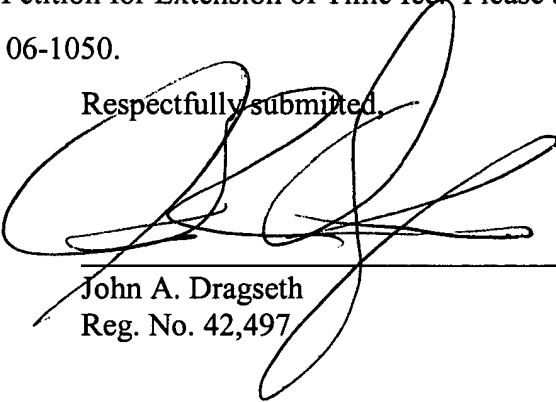
Applicant : Leonid Raiz et al.  
Serial No. : 09/755,975  
Filed : January 5, 2001  
Page : 14 of 14

Attorney's Docket No.: 15786-042001

Enclosed is a \$60.00 check for the Petition for Extension of Time fee. Please apply any other charges or credits to deposit account 06-1050.

Respectfully submitted,

Date: 9-19-05

  
\_\_\_\_\_  
John A. Dragseth  
Reg. No. 42,497

Fish & Richardson P.C., P.A.  
60 South Sixth Street  
Suite 3300  
Minneapolis, MN 55402  
Telephone: (612) 335-5070  
Facsimile: (612) 288-9696